

Serial No: 09/683,713
Filed: February 6, 2002
Group Art Unit: 2872

REMARKS

Drawings

The Patent Office has objected to the drawings under 37 C.F.R. §1.83(a) as allegedly not showing every feature of the invention specified in the claims. The Claims as amended are now in compliance with 37 C.F.R. §1.83(a). Withdrawal of the objection is respectfully requested.

Specification

The Patent Office has objected to the disclosure due to informalities. The specification has been amended to change reference number "290" on page 10, line 8 to "390". Thus, it is requested that the Patent Office withdraw their objection.

Claim Rejections

35 U.S.C. §112, first paragraph

The Patent Office has rejected Claims 1, 3-6, 8-18, under 35 U.S.C. §112, first paragraph.

Applicant respectfully asserts that independent Claim 1 as amended is in compliance with the requirements of 35 USC §112, first paragraph. Claims 3-6, 8-18 depend off amended Claim 1 and comply with 35 USC §112, first paragraph.

35 U.S.C. §102(e)

The Patent Office has rejected Claims 1, 8-12, 14, 16 and 18 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,025,956 to Nagano et al. ("Nagano").

It is well established that a claim is anticipated under 35 U.S.C. §102, ONLY IF each and every element of the claim is found in single prior art reference¹. Moreover, to anticipate a claim under 35 U.S.C. §102, a single source must contain each and every element of the claim "arranged as in the claim."^{2,3} Finally, missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference.⁴ If each and every element of a claim is not found in a single reference, there can be no anticipation.

¹ *Veregal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987).

² *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

³ *Lewmar Marine Inc. v. Barent, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q. 2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988).

⁴ *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

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Applicant respectfully asserts amended Claim 1 is not anticipated by Nagano. In particular, Applicant's attorney has been unable to find in Nagano any disclosure of "the optical component is configured to vary the amplitude, phase or polarization of the light and thereby to modify a shape of the illumination PSF of the light in the illuminating beam path and/or the detection PSF in the detection beam path of the double confocal scanning microscope". Also, amended Claim 1 recites a specific feature of a double confocal microscope, such as the same length of the illumination beam path for both microscope objectives. Therefore, amended Claim 1 is not anticipated by Nagano and Claims 8-12, 14, 16 and 18 dependent from amended Claim 1 are not anticipated by Nagano either. It is respectfully requested that the rejection be withdrawn.

35 U.S.C. §102(b)

The Patent Office has rejected Claims 1, 3-6, 8, 10, 13-17 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,587,832 to Krause ("Krause").

Amended Claim 1 recites "the optical component is configured to vary the amplitude, phase or polarization of the light and thereby to modify a shape of the illumination PSF of the light in the illuminating beam path and/or the detection PSF in the detection beam path of the double confocal scanning microscope". Also, amended Claim 1 recites a specific feature of a double confocal microscope, such as the same length of the illumination beam path for both spaced apart microscope objectives. None of those features could be found in Krause. Therefore, Claim 1 as amended, as well as dependent claims 3-6, 8, 10, 13-17, cannot be anticipated by Krause. Withdrawal of the rejection is respectfully requested.

Additionally, the Patent Office has rejected Claims 1, 3-6, 8, 10-12, 14, 16-18 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,386,112 to Dixon ("Dixon").

Amended Claim 1 recites "the optical component is configured to vary the amplitude, phase or polarization of the light and thereby to modify a shape of the illumination PSF of the light in the illuminating beam path and/or the detection PSF in the detection beam path of the double confocal scanning microscope". Also, amended Claim 1 recites a specific feature of a double confocal microscope, such as the same length of the illumination beam path for both spaced apart microscope objectives. None of those features could be found in Dixon. Therefore,

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Claim 1 as amended, as well as dependent claims 3-6, 8, 10-12, 14, 16-18 cannot be anticipated by Dixon. Withdrawal of the rejection is respectfully requested.

The Patent Office has rejected Claims 1, 3-6, 8, 10-12, 14, 16-18 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,671,085 to Gustaffson ("Gustafsson").

Amended Claim 1 recites "the optical component is configured to vary the amplitude, phase or polarization of the light and thereby to modify a shape of the illumination PSF of the light in the illuminating beam path and/or the detection PSF in the detection beam path of the double confocal scanning microscope". Also, amended Claim 1 recites a specific feature of a double confocal microscope, such as the same length of the illumination beam path for both spaced apart microscope objectives. None of those features could be found in Gustaffson.. Therefore, Claim 1 as amended, as well as dependent claims 3-6, 8, 10-12, 14, 16-18 cannot be anticipated by Gustaffson. Withdrawal of the rejection is respectfully requested.

CONCLUSION

It is now believed that independent Claim 1 and its dependent Claim 2-18 are now in condition for allowance, which is respectfully requested.

The Examiner is kindly invited to telephone the undersigned to resolve any questions to expedite the allowance of the pending Claims.

The listing of Claims is presented as a complete marked-up listing of Claims (without the clean version) in accordance with the Pre-OG Notice of the Office of Patent Legal Administration of 1-31-03

(<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>).

Respectfully submitted,

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